



PATENT INV.0005P

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Elia Rocco Tarantino )

Group Art Unit 3714

Appl. No. : 10/810,782 )

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450, on

Filed : March 26, 2004 )

November 9, 2009

For : GAME USING SECONDARY  
INDICIA PROVIDING GAME  
STATUS INFORMATION )

(Date)  
R. Scott Weide, Reg. No. 37,755

Examiner : Malina K. Rustemeyer )

**APPEAL BRIEF**

Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sirs:

Applicant hereby files this Appeal Brief in furtherance of the Notice of Appeal filed

August 10, 2009.

11/13/2009 EFLORES 00000002 10010782

01 FC:2402  
02 FC:2251

- 270.00 OP  
65.00 OP

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**Filed** : April 19, 2006

**I. REAL PARTY IN INTEREST**

The subject application is owned by and the real party in interest is Patent Investment Corporation, a Nevada limited liability company.

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**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

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**III. STATUS OF CLAIMS**

Claims 1-9 are pending in the application.

Claims 10-15 are cancelled.

Claims 16 and 17 are pending in the application.

All pending claims, namely Claims 1-9 and 16-17, were rejected in the Office Action mailed May 8, 2009, and are subject to this appeal.

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**IV. STATUS OF AMENDMENTS**

No amendments have been filed after the May 8, 2009, Office Action.

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**V. SUMMARY OF CLAIMED SUBJECT MATTER**

In general, the invention is directed to a keno-type game in which a player selects player numbers from a base set of numbers, a set of game numbers are then selected from the same base set of numbers, and then the player and game numbers are compared for matches. For example, a player might select 7 player numbers from a base set of numbers 1-80. See Application at Figure 2 (where a game board of 80 numbers is shown with player selected numbers highlighted). A set of game numbers, such as 20 game numbers, is then randomly selected from the base set of numbers 1-80. See Application at Figures 3 and 4 (where game numbers are shown as parachuting characters). The 20 selected game numbers are compared to the 7 player selected numbers to determine potential matches. A player may be declared a winner if a sufficient number of the selected game numbers and player selected numbers match one another.

In accordance with the invention, indicators are utilized to convey to a player the status of the game, such as the numbers they have selected, the selected game numbers, and game outcomes or results (namely, the determination of whether the player's numbers have been matched by the game numbers). In one embodiment of the invention, player selected numbers are designated with a first indicator. Such an indicator might comprise, for example, highlighting of the selected numbers. See Application at Figure 2. As to each player number which is matched by a game number, the first indicator is *removed* and a match indicating secondary indicia which does not include the first indicator is displayed. Such a match-indicating secondary indicia might comprise, for example, a character conveying a happy or winning condition. See Application at Figures 3 and 4. As to each player number which is not matched by a game number, the first indicator is *removed* and a non-

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match indicating secondary indicia is displayed, that secondary indicia not including the first indicator and differing from a match indicating secondary indicia. Such a non-match indicating secondary indicia might comprise, for example, a character conveying a negative condition, such as a sad state. See Application at Figure 5. In this manner, one indicator is used to designate to the player their selected numbers. Then, when the game numbers are compared, new and different secondary indicia are displayed to show to the player the game results, namely, whether each of the player's numbers which were matched or not matched.

#### Independent Claim 1

Claim 1 recites a method of playing a game of keno at a gaming device comprising the following steps:

a) displaying a set of keno numbers;

\* See Application text at ¶¶ [0028] – [0029] and Figure 1 wherein a set of numbers 1-80 are shown

b) accepting input from a player regarding one or more player selected numbers from said keno numbers;

\* See Application text at ¶¶ [0031] wherein a player makes number selections

c) designating said player selected numbers with a first indicator;

\* See Application at Figure 1 wherein player selected numbers are highlighted

d) selecting a set of game numbers;

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\* See Application text at ¶¶ [0032] – [0034] and Figures 3 and 4 wherein game numbers are illustrated, such as by parachuting characters

e) determining if one or more of said game numbers match one or more of said player selected numbers;

\* See Application text at ¶ [0036]

f) as to each player number which is matched by a game number, removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number, said match indicating secondary indicia not including said first indicator and said match indicating secondary indicia having an attribute indicating to said player that said player number was matched; and

\* See Application text at ¶¶ [0038] – [0039] and Figures 3-5 wherein the first indicator (highlighting) is removed and replaced with a match-indicating indicia for each player selected number that is matched by a selected game number, the match-indicating indicia indicating a winning/positive outcome, such as comprising a character portraying a happy condition

g) as to each player number which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator, said non-match indicating secondary indicia differing from said match indicating secondary indicia, and said non-match indicating secondary indicia having an attribute indicating to said player that said player was not matched; and



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\* See Application text at ¶ [0040] and Figures 3-5 wherein the first indicator (highlighting) is removed and replaced with a non-match indicating indicia for each player selected number that is not matched by a selected game number, the non-match indicating indicia indicating a losing/negative outcome, such as comprising a character portraying a sad condition

h) determining the outcome of said game.

\* See Application text at ¶¶ [0036] and [0056]

#### Dependent Claim 2

Claim 2 recites the method of Claim 1 wherein the match indicating and non-match indicating indicia are Smiley characters

\* See Application text at ¶¶ [0041] and [0053]

#### Dependent Claim 3

Claim 3 recites the method of Claim 1 wherein an attribute indicating a match is an animation of the secondary indicia to indicate happiness or celebration

\* See Application text at ¶¶ [0039] and [0052] and Figures 3-5

#### Dependent Claim 4

Claim 4 recites the method of Claim 1 wherein an attribute indicating no match is an animation of the secondary indicia to indicate unhappiness or loss

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\* See Application text at ¶¶ [0039] and [0052] and Figures 3-5

#### Dependent Claim 5

Claim 5 recites the method of Claim 1 wherein one or more of the match indicating secondary indicia differ from one another in appearance

\* See Application text at ¶ [0040] and Figures 3-5

#### Dependent Claim 6

Claim 6 recites the method of Claim 1 wherein a matching indicating or non-match indicating secondary indicia is displayed in physical proximity to each player selected number

\* See Application text at ¶ [0038] and Figures 3-5

#### Dependent Claim 7

Claim 7 recites the method of Claim 1 wherein the secondary indicia are other than numbers

\* See Application text at ¶¶ [0039] – [0041], [0048] and Figures 3-5

#### Dependent Claim 8

Claim 8 recites the method of Claim 1 wherein the game is played as a wagering type game and including the step of accepting a wager from a player to play the game

\* See Application text at ¶ [0042]

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Dependent Claim 9

Claim 9 recites the method of Claim 1 wherein the steps of displaying are performed on a video display of said gaming device

\* See Application text at ¶ [0043] and Figure 1

Dependent Claim 16

Claim 16 recites the method of Claim 1 wherein the first indicator comprises highlighting of said keno numbers which comprise player selected numbers

\* See Application at Figures 2 and 3

Dependent Claim 17

Claim 17 recites the method of Claim 1 further including the step of indicating the selected game numbers by a second indicator

\* See Application text at ¶ [0033] – [0034] and Figures 3 and 4

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**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

There are 2 grounds of rejection presented for review:

- (1) Rejection of Claims 1, 6, 8, 9, 16 and 17 under 35 U.S.C. § 103(a) as unpatentable over Luciano, Jr. (US Pub. 2003/0232638) in view of Beaulieu et al. (US Pub. 2003/0017865); and
- (2) Rejection of Claims 2-5 and 7 as being unpatentable over that combination in further view of Bennett et al. (WO 2000/32286).

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## VII. ARGUMENTS

A. Rejection of Claims 1, 6, 8, 9, 16 and 17 35 U.S.C. § 103(a) as being *unpatentable* over Luciano, Jr. in view of Beaulieu et al.

The foundation of this one of the Examiner's rejection's is the teachings of Luciano, Jr. Luciano, Jr., however, discloses a keno game of the prior art having the shortcomings that the present invention addresses. In particular, Luciano, Jr., discloses a keno game which lacks indicators which clearly convey to a player whether player numbers have been matched or not as an indicator of the outcome of the game.

In particular, Luciano, Jr., discloses a keno game which only uses two types of indicators: one indicator is used to designate selected player numbers and another indicator is used to designate selected game numbers. As illustrated in Figure 4 of Luciano, Jr., player selected numbers are indicated with a check mark. Selected game numbers are highlighted, as illustrated in Figure 5. In this configuration, however, no other indicia or indicators are provided or utilized to indicate the outcome of the game in the form of matched or un-matched player selected numbers and game numbers. Instead, the player must assess the player and game numbers in order to determine whether they were matched.

Claim 1 recites a keno game including displaying keno numbers and designating player selected numbers with a first indicator in similar fashion to Luciano, Jr.. However, Claim 1 also recites that, as to each player selected number that is matched, the method includes the step of removing the first indicator and displaying a match indicating secondary indicator in association with

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the player selected number, where the match indicating secondary indicia does not include the first indicator. As the Examiner admits (at page 3 of the May 8, 2009, Office Action), Luciano, Jr., does not teach or suggest such. As indicated above, Luciano, Jr., does not utilize any secondary indicia to indicate matches or non-matches. The Examiner asserts that Luciano discloses displaying a matching indicating indicia for each matched player number (in the form of a box including a check mark and shading) and displaying non-match indicating secondary indicia in association with each unmatched player number (in the form of a box that is unchecked and shaded). However, these are simply combinations of the basic indicators used to designate the player numbers and game numbers and are not different secondary indicia that indicate matches or non-matches.

Second, Claim 1 requires that as to each player number that is not matched, removing the first indicator and displaying a non-match indicating secondary indicia *which does not include the first indicator and which is different than the match indicating secondary indicia*. Luciano, Jr., does not disclose or suggest such. In particular, in Luciano, Jr., the original “check marks” designating player selected numbers are not removed even if the player number is not matched. In fact, in Luciano, Jr., no change is made to the original check marks to show that a player number was not matched. In particular, unmatched player numbers are still designated by a check-mark (selected game numbers which do not match player numbers are shown with highlighting, but no “non-matching indicia” are displayed in place of a check mark relative to each player number that was not matched).

Exhibit A illustrates the fundamental differences between the present invention and Luciano, Jr. As illustrated therein, both the present invention and Luciano, Jr., disclose using a first indicator (such as a check mark or shading) to designate selected player numbers. Further, in Luciano, Jr.,

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game numbers are designated by another indicator, such as highlighting. However, in Luciano, Jr., no different secondary indicia or indicators are used to designate matches or non-matches of player numbers. On the other hand, in accordance with the present invention, the first indicator which was used to designate player selected numbers is entirely removed and new secondary indicia are used which indicate either a match or non-match of the player number to the game numbers.

A fundamental aspect of the benefits of the present invention can be appreciated from this example. In the case of Luciano, Jr., a player must decipher the combinations of the basic indicators to determine the status of the game. For example, the player must decipher the meaning of checked but unhighlighted numbers, check and highlighted numbers, highlighted and unchecked numbers, and unhighlighted and unchecked numbers. On the other hand, in accordance with the invention, the status of each originally selected player number in comparison to the selected game numbers is indicated by a new secondary indicia which clearly indicates to the player the game results, namely whether each player number was either matched or not matched.

The Examiner further cites Beaulieu et al. as disclosing the replacement of indicia and asserts that it would be obvious to modify Luciano, Jr. to utilize the symbol configuration of Beaulieu et al. to generate the present invention. However, Beaulieu et al. actually discloses that the appearance of indicia may be changed through the progression of a game. For example, Beaulieu et al. discloses that symbols on a slot reel may become more animated as the player gets closer to a winning game combination. See Beaulieu et al. at Figures 13-16, for example, and the text at ¶ [0088].

However, this teaching does not remedy the deficiencies of Luciano, Jr. Both Luciano, Jr., and Beaulieu et al. disclose that various symbols may be used in the play of a game. However, these

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references do not disclose, either alone or in combination, use of a first indicator to designate player numbers and then secondary indicia in replacement of the original indicators to designate the outcome of the game (i.e. secondary indicia indicating matches or non-matches of those numbers by game numbers) as claimed in Claim 1.

The cited prior art can not render the claimed invention obvious because the cited combination must disclose each and every element recited in Claim 1. As indicated above, the cited prior art simply shows using certain basic symbols or indicators to designate original components or elements of a game (such as in Luciano, Jr., where basic indicators are used to designate player and game numbers). However, the cited prior art does not teach or suggest utilizing a completely different secondary indicia to indicate game results, and in particular the prior art doesn't show or suggest using secondary indicia having features indicating matches or non-matches of the separate player and game numbers. For example, like Luciano, Jr., Beaulieu et al. does not disclose removing one indicia showing a player selected number and displaying a different match indicating indicia for each player number that is matched, and displaying yet a different non-match indicating indicia for each player number that is not matched (Beaulieu et al. at most discloses that the appearance of certain base indicia may change, not the concept of using a first indicator to designate one element in a game and then using a completely different secondary indicia to indicate a game result). Because the combination of Luciano, Jr. and Beaulieu et al. does not disclose (even when combined) each and every element of Claim 1, this ground of rejection fails as to Claim 1.

In addition, Applicant asserts that it is not obvious to modify Luciano, Jr., with the teachings of Beaulieu et al., and as a result, such a combination is improper in the first instance. For example, it is



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not even clear how the concept of changing the appearance of indicia disclosed in Beaulieu et al. could be applied to Luciano, Jr. In a game of keno, there are no incremental “stages” working towards a potential end result where changing the appearance of indicia shows how close the player is to a particular result. In the game of keno, player numbers are either matched or they are not matched. Luciano, Jr. already discloses that indicia (check marks and highlighting) may be used to designate player numbers and game numbers. It is not clear how those check marks and highlights could change appearance over time per Beaulieu et al., but in any event, such would still not result in the manner of designation as claimed. Applicant thus asserts that one of ordinary skill in the art would not attempt to modify Luciano, Jr., in view of Beaulieu et al. and that such an asserted combination is improper.

Dependent Claims 6, 8, 9, 16 and 17

In that the prior art fails to disclose the limitations of base independent Claim 1, Applicant asserts that Claims 6, 8, 9, 16 and 17 dependent thereon are allowable. In addition, Applicant asserts that certain of the limitations in these claims are not disclosed by the cited prior art, and thus the cited prior art can not render the claimed invention obvious. For example, Claim 16 recites a game in which player selected numbers are highlighted. Neither cited reference discloses this configuration.

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B. Rejection of Claims 2-5 and 7 under 35 U.S.C. § 103(a) as being *unpatentable* over Luciano, Jr. in view of Beaulieu et al. in view of Bennett et al.

In that the prior art fails to disclose the limitations of base independent Claim 1, Applicant asserts that Claims 2-5 and 7 dependent thereon are allowable. In addition, however, Applicant asserts that the addition of Bennett et al. does not remedy this shortcoming.

The Examiner cites Bennett et al. against Claims 2-5 and 7 relative to a disclosure of animated figures. This disclosure does not remedy the deficiency of the base references as failing to teach all of the limitations of Claim 1 upon which these claims depend.

In addition, Applicant asserts that it would not be obvious to modify the combination of Luciano, Jr. and Beaulieu et al. with the teachings of Bennett et al. Bennett et al. discloses use of an animated character such as a “Mr. Cashman” character (see Figure 20(b)). This character may be used to “communicate information to a player” (see Bennett et al. at Abstract). However, Bennett et al. discloses use of such a character in addition to a base game, and not in a configuration where such a character is used as a secondary indicia in replacement of other indicators to indicate game outcome information. Thus, Applicant asserts that it would not be obvious to use such a character in a game such as Luciano, Jr. In particular, applying the teaching of Bennett et al. to Luciano, Jr., simply results in a secondary character being introduced over the keno game, separate from the keno numbers and selected player and game numbers. For example, in such a combination a “Mr. Cashman” character might pop into Luciano, Jr.’s game in order to give a bonus prize or the like (see Bennett et al. at page 25). In addition, even if Bennett et al. is utilized for the teaching of the use of an animated symbol, combining that concept with the combination of Luciano, Jr. and Beaulieu et al. simply

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results in animated indicators for indicating selected player and game numbers and not use of secondary indicia to designate game results (since neither Luciano, Jr. or Beaulieu et al. disclose such a feature and therefore there is no such feature to be modified).

For these reasons, Applicant further asserts that the subject matter of Claims 2-5 and 7 is patentable over the cited prior art.

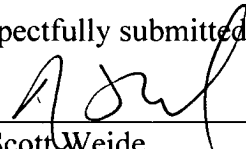
Summary

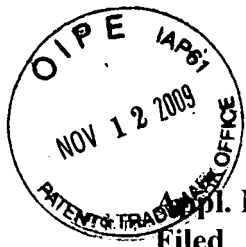
Applicant requests allowance of pending Claims 1-9 and 16-17 for the reasons advanced above.

Dated: November 9, 2009

By: \_\_\_\_\_

Respectfully submitted,

  
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#### **VIII. CLAIMS APPENDIX**

1. A method of playing a game of keno at a gaming device comprising the steps of:  
  
displaying a set of keno numbers;  
  
accepting input from a player regarding one or more player selected numbers from said keno numbers;  
  
designating said player selected numbers with a first indicator;  
  
selecting a set of game numbers;  
  
determining if one or more of said game numbers match one or more of said player selected numbers;  
  
as to each player number which is matched by a game number, removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number, said match indicating secondary indicia not including said first indicator and said match indicating secondary indicia having an attribute indicating to said player that said player number was matched;  
  
and  
  
as to each player number which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator, said non-match indicating secondary indicia differing from said match indicating secondary indicia, and said non-match indicating secondary indicia having an attribute indicating to said player that said player was not matched; and

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determining the outcome of said game.

2. The method in accordance with Claim 1 wherein said set of match indicating and non-match indicating secondary indicia are Smiley characters.

3. The method in accordance with Claim 1 wherein said attribute indicating a match is animation of said secondary indicia to indicate happiness or celebration.

4. The method in accordance with Claim 1 wherein said attribute indicating no match is animation of said secondary indicia to indicate unhappiness or loss.

5. The method in accordance with Claim 1 wherein one or more of the match indicating secondary indicia differ from one another in appearance.

6. The method in accordance with Claim 1 wherein a matching indicating or non-match indicating secondary indicia is displayed in physical proximity to each player selected number.

7. The method in accordance with Claim 1 wherein said secondary indicia are other than numbers.

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8. The method in accordance with Claim 1 wherein said game is played as a wagering type game and including the step of accepting a wager from a player to play said game.

9. The method in accordance with Claim 1 wherein said steps of displaying are performed on a video display of said gaming device.

10. – 15. (Canceled)

16. The method in accordance with Claim 1 wherein said first indicator comprises highlighting of said keno numbers which comprise player selected numbers.

17. The method in accordance with Claim 1 further including the step of indicating said selected game numbers by a second indicator.

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**IX. EVIDENCE APPENDIX**

There is a single Exhibit A comprising the evidence appendix to this Appeal Brief.

LUCIANO

✓1	2	3	✓4
5	✓6	7	8

PLAYER NUMBERS  
1, 4, 6 SELECTED

MATCHED PLAYER  
NUMBERS STILL SHOW  
CHECK MARK

✓1	2	3	✓4
5	✓6	7	8

GAME NUMBERS  
1, 3, 7 SELECTED

NON-MATCHED  
PLAYER NUMBERS  
STILL SHOW  
CHECK-MARK

TARANTINO

1	2	3	4
5	6	7	8

PLAYER NUMBERS  
1, 4, 6 SELECTED

MATCHED PLAYER  
NUMBER HAS  
INITIAL INDICIA  
REMOVED AND MATCH  
INDICATOR SHOWN

☺	2	3	☹
5	☹	7	8

GAME NUMBERS  
1, 3, 7 SELECTED

UNMATCHED PLAYER  
NUMBERS HAVE INITIAL  
INDICIA REMOVED AND  
NON-MATCH INDICATOR  
DISPLAYED

EXHIBIT "A"



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**X. RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.